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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,604	12/03/2003	David Brian Wecker	5486-0255PUS1	4652
67321 7590 01/27/2009 BIRCH, STEWART, KOLASCH & BIRCH, LLP PO Box 747 FALLS CHURCH, VA 22040-0747				
EXAMINER VANCHY JR, MICHAEL J				
ART UNIT 2624		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/725,604

Applicant(s)

WECKER ET AL.

Examiner

MICHAEL VANCHY JR

Art Unit

2624

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 27-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 and 27-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 13, 2009 has been entered.

Response to Arguments

1. Applicant's arguments filed August 13, 2008 have been fully considered but they are not persuasive. The response to the arguments can be found at the end of this office action.
2. Claims 24-26 have been cancelled.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 15-18, 19, 20, 22, 23, 28, 29, 31, and 32 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The Applicant states that a "computer-readable medium" can be any available media, which can then be "Communication media" as described by the Applicant, which can be a modulated data signal, such as a carrier wave ([0023]) with is non-statutory subject matter. Since a "system" can be a "computer-readable medium" the same rejection applies to the claimed system. Appropriate correction is required.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. **Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gounares et al., US 2003/0215142 A1.**

Regarding claim 1, Gounares teaches a method, comprising: receiving electronic ink input; converting the electronic ink input to one or more machine-generated objects; and rendering the one or more machine-generated objects such that a size and an inter-word spacing of the rendered machine-generated object or objects substantially corresponds to an original size and an original inter-word spacing of the electronic ink input (Figs. 5 and 6, [0037], The examiner takes into account that "printed text" corresponds to "machine-generated objects, and that the size and inter-word spacing is substantially equal to the original size of the electronic ink input as seen in Figures 5 and 6.).

Regarding claim 2, Gounares teaches a method according to claim 1, further comprising: determining the original size of the electronic ink input ([0037], The examiner takes into account that since "The displayed ink may be scaled to the current input font size," it is clear that the original input size is determined.).

Regarding claim 3, Gounares teaches a method according to claim 2, wherein the original size of the electronic ink input is determined based on an average size of at least a portion of the electronic ink input ([0029], "The color and/or font size of the textual ink, as well as whether the textual ink should be underlined, bold, italic, and/or the like may be set programmatically and **may be based on the attributes of the text around the tink object.**").

Regarding claim 4, Gounares teaches a method according to claim 1, further comprising: receiving input selecting at least one object from the rendered machine-generated object or objects; and displaying the electronic ink input corresponding to the selected machine-generated object or objects in place of the selected at least one object (Fig. 5 and [0037]).

Regarding claim 5, Gounares teaches a method according to claim 4, wherein the displayed electronic ink input temporarily replaces the rendered machine-generated object or objects ([0037] and [0041], The examiner takes into account that since the InkEdit control can display either the original ink or the recognized text or both, that it is clear that the electronic ink input can temporarily replace the rendered machine-generated text.).

Regarding claim 6, Gounares teaches a method according to claim 1, wherein the one or more rendered machine-generated objects are arranged so as to correspond to an original arrangement of the electronic ink input (Figs. 5 and 6, [0037]).

Regarding claim 7, Gounares teaches a method according to claim 1, wherein the electronic ink input includes electronic ink text input, the one or more machine-generated objects includes machine-generated text, and the size of at least some of the machine-generated objects constitutes a font size of the machine-generated text (Figs. 5 and 6, [0037]).

Regarding claim 8, Gounares teaches a method according to claim 7, further comprising: determining the original size of the electronic ink text input on a word-by-word basis: wherein at least two words are separated by said original inter-word spacing (Fig. 3, and [0040]). The examiner takes into account that since size can be determined by the InkEdit control, and since some ink can be selected by creating a box, it is clear that each word can be selected and the size of that word be determined while keeping the original inter-word spacing.).

Regarding claim 9, Gounares teaches a method according to claim 8, wherein the machine-generated text is rendered, on the word-by-word basis, at a font size based on the determined original size of the electronic ink text input (Figs 3-6, [0039-0040]).

Regarding claim 10, Gounares teaches a method according to claim 7, further comprising: determining the original size of the electronic ink text input as an average size of a line of the electronic ink text input ([0029], "The color and/or font size of the textual ink, as well as whether the textual ink should be underlined, bold, italic, and/or the like may be set programmatically and **may be based on the attributes of the text around the tink object.**"), on a line-by-line basis, wherein at least one line includes at least two words separated by said original inter-word spacing (Fig. 3, and [0040]). The examiner takes into account that since size can be determined by the InkEdit control, and since some ink can be selected by creating a box, including an entire line, it is clear that each word can be selected and the size of that word be determined while keeping the original inter-word spacing.).

Regarding claim 11, Gounares teaches a method according to claim 10, wherein the machine-generated text is rendered, on the line-by-line basis (Fig. 3, and [0040], The examiner takes into account that since size can be determined by the InkEdit control, and since some ink can be selected by creating a box, including an entire line, it is clear that each word can be selected and the size of that word be determined while keeping the original inter-word spacing.), at a font size based on the average size of the electronic ink text input line ([0029], "The color and/or font size of the textual ink, as well as whether the textual ink should be underlined, bold, italic, and/or the like may be set programmatically and **may be based on the attributes of the text around the tink object.**").

Regarding claim 12, Gounares teaches a method according to claim 7, further comprising: receiving input selecting one or more words from the rendered machine-generated text; and displaying the electronic ink text input corresponding to the selected machine-generated text (Fig. 3, [0006], [0037] [0040], The examiner takes into account that since some ink can be selected by creating a box and that the ink can be saved, it is clear that the saved ink can be recalled and replace the machine-generated text.).

Regarding claim 13, Gounares teaches a method according to claim 12, further comprising: displaying machine-generated text alternatives corresponding to the selected one or more words ([0045]).

Regarding claim 14, Gounares teaches a method according to claim 13, further comprising: receiving input selecting a displayed machine-generated text alternative; and replacing the selected rendered machine-generated text with the selected displayed machine-generated text alternative ([0045]).

Regarding claim 15, see rejection made to claim 1, for it addresses the method of this system.

Regarding claim 16, see rejection made to claim 7, for it addresses the method of this system.

Regarding claim 17, see rejection made to claim 13, for it addresses the method of this system.

Regarding claim 18, see rejection made to claim 14, for it addresses the method of this system.

Regarding claim 19, see rejection made to claim 1, for it addresses the method of this computer-readable medium.

Regarding claim 20, see rejection made to claim 7, for it addresses the method of this computer-readable medium.

Regarding claim 21, Gounares teaches a method of claim 1, wherein said step of rendering comprises: rendering the one or more machine-generated objects such that a word positioning of the rendered machine-generated object or objects substantially corresponds to an original word positioning of the electronic ink input ([0037]).

Regarding claim 22, see rejection made to claim 21, for it addresses the method of this system.

Regarding claim 23, see rejection made to claim 21, for it addresses the method of this computer-readable medium.

4. Claims 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gounares et al., US 2003/0215142 A1, and further in view of Wakeam et al., US 2005/0041834 A1.

Regarding claims 27-29, Gounares teaches the ability to interpret a drawing or any other non-textual context that is written with the electronic ink ([0029]), and thus can keep positioning and spacing the same or as desired by the user ([0040]). However, Gounares does not explicitly state that the input is a table with rows and columns. Wakeam teaches using electronic ink to input a table with rows and columns (Fig. 15A and [0111]). Therefore, it would be clear to one of ordinary skill in the art at the time of the invention to modify Gounares to include tables with rows and columns as "non-textual content," for further accurately editing and manipulating the electronic ink.

5. Claims 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gounares et al., US 2003/0215142 A1, and further in view of Geidl et al., US 2003/0053084 A1.

Regarding claim 30, Gounares teaches inter-word spacing and character recognition, to turn electronic ink into text, however, Gounares is silent on using normalization. Geidl teaches normalizing said inter-word spacing in response to a user-generated normalization command (Figs. 3 and 8, [0044] and [0059], The examiner takes into account that since the normalization data is saved, so that the normalization can be undone, it is clear that the user can control the normalization.). It would be clear to one of ordinary skill in the art at the time of the invention to modify Gounares to include "normalization," so that a more typical word processing format is created, for easier reading and understanding.

Regarding claim 31, see rejection made to claim 30, for it addresses the method of this system.

Regarding claim 32, see rejection made to claim 30, for it addresses the method of this computer-readable medium.

Response to Arguments

6. The arguments made by the Applicant have been considered but are not persuasive. The three arguments the Applicant brings up are that the prior art does not reach "a size and inter-word spacing substantially corresponding to an original size and original inter-word spacing," "arranged so as to correspond to an original arrangement," and "that a word positioning substantially corresponds to an original word positioning." First, the Examiner would like to point out that the word "substantially" is a relative term.

Thus, the examiner points out that the text found in Figs. 3 and 5 (Gounares et al., US 2003/0215142 A1) are "substantially" corresponding to each other. However, the Examiner would also like to point out that the Figures are merely examples of the prior art's invention. The Examiner points the Applicant to [0037] of the prior art, which states, "The displayed ink may be scaled to the current input font...and may be displayed inline with other text, and/or may otherwise be altered in its position, size and/or color. Alternatively, the displayed ink may retain its original position, size, and/or color." Thus, the "spacing," "arrangement," and "positioning" can all be displayed the way the user desires in the prior art, which corresponds to the method described by the Applicant.

Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL VANCHY JR whose telephone number is (571)270-1193. The examiner can normally be reached on Monday - Friday 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samir Ahmed can be reached on (571) 272-7413. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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